Remarks

Claims 2 and 4 are finally rejected under 35 USC §102(e) as lacking novelty over several references. Claims 2 and 4 are finally rejected under the doctrine of obviousness double patenting over the claims of several patents. Entry of the foregoing amendments and consideration of the Arguments and Remarks below are respectfully requested.

Request for Withdrawal of the Final Rejection. Applicants request withdrawal of the Final Rejection because the basis of the previous non-final rejection was not adequately explained in the office action that was mailed July 21, 2009. The office action of July 21, 2009, made the contention that the claims, which are directed to treating neuropathic pain with CCR2 antagonists, also are directed to preventing neuropathic pain. The examiner stated that the "claims encompass administering the elected compound to any patient for the prevention of neuropathic pain (as defined on page 3 of the specification)" five times (once for each of 5 cited patents) on pages 3 and 4 of the July 21 Office Action. The claims were rejected as lacking novelty based on their including "prevention." The "definition" that the examiner referred to on page 3 clearly did not redefine treatment as also including prevention. The passage on page 3, line 7, of the application states that "CCR-2 antagonists treat, ameliorate and/or prevent neuropathic pain" without any suggestion that the words "treat," "ameliorate" and "prevent" have meanings other than their usual meanings.

In the final rejection that was mailed December 4, 2009, the examiner cited a different passage from the application to rebut arguments that were made in response to the July 21 Office Action. The passage cited by the examiner in the Final Rejection is in Paragraph [2282] of the publication of the application, and does explicitly state that "the term 'treatment' refers both to the treatment and to the prevention or prophylactic therapy of the mentioned conditions..." This passage was not previously cited by the examiner, and the applicants therefore were not given the opportunity to consider this passage before the issuance of a final rejection. This passage is taken into consideration in the amendment provided herein.

Amendment/Rejections under 35USC § 102(e). Claims 2 and 4 have been amended as follows. In each claim, the meaning of "treatment" has been explicitly defined as not including prevention or prophylactic therapy, so that there is no uncertainty of the meaning of "treating" in the claims. The word "treatment" in paragraph [2282] includes both the broadened definition, which includes treatment and prevention or prophylactic therapy, and the conventional meaning, which is one of the two choices that was provided for the broader meaning, the other choice being prevention or prophylactic therapy. It is now clear in the claim language that the amended claims are directed only to treating neuropathic pain.

By limiting the claims to the conventional meaning of "treating," patients who have been treated with CCR2 antagonists for any indication have not also been inherently treated for prevention of neuropathic pain. Patients being treated with CCR2 antagonists for neuropathic pain are patients in need of treatment according to the claims, and are thus patients who already have been diagnosed as having neuropathic pain. Previous treatment of patients with CCR2 antagonists for other indications will not have inherently anticipated treatment of the patients for neuropathic pain, since the population groups are different.

Because the claim rejections under 35USC §102(e) appear to be solely based on the interpretation of "treating" as also including "preventing", these rejections should be withdrawn.

Applicants also argued in the last response that prior art patents were generally directed to the treatment or prevention of inflammatory and immunoregulateory disorders. It was further stated that there is no reason to expect these disorders to be accompanied by pain, such as neuropathic pain. This statement was rebutted by the Examiner as an unsupported allegation. However, this statement was meant to point out that the Examiner first has the burden of providing evidence that treatment of inflammatory and immmunoregulatory disorders would anticipate or include treatment of neuropathic pain. This issue is believed to be moot now because "prevention" is clearly excluded based on the claim language.

Double Patenting Rejections.

The Examiner has continued to reject the claims for obviousness-type double patenting over three patents and two patent applications which are now patents. Of these, only two patents have claims that are directed to the specific compounds that are claimed in these applications: US Patents 6,812,234 and 7,230,008. The '234 patent has claims that are directed to the compounds in this application, but the patent has claims directed only to chemical compounds. The '008 patent has claims that are directed to methods of using the compounds claimed in the pending application. The claimed uses are as follows:

- Claims 1-11 = Methods of treating an inflammatory disorder or disease; and
- Claim 12 = Method of modulation of chemokine receptor activity in a mammal.

The Examiner's rejection that the claims of the current application conflict with the claims of these patents is based on the argument that the pending claims are embraced by the patented claims, and specifically that the claims of the application include prevention of neuropathic pain (page 6, last 3 paragraphs of the Office Action of December 4, 2009). This is now moot, since prevention is clearly excluded.

The other cited patents are directed to generic groups of compounds that do not overlap the currently claimed compounds. The substituent groups that prevent overlap are briefly summarized below:

- US Patent 7,393,844 - The B Group in the '844 patent is different than the corresponding group in the pending application.

- US Patent 7, 166,614 - The right hand aromatic ring in the '614 patent is carbocyclic whereas the corresponding ring in the current application contains nitrogen.

- US Patent 7,390,803 - The '803 patent has a phenyl ring on the right side of the structure. whereas the pending application has a fused bicyclic group on the night side.

- 10/260,008, now US 7,598,243 - The cyclopentyl ring in Formula I of the '243 patent is connected directly to the heterocyclic ring on the left side of the structure, whereas the cyclopentyl ring is connected to the left hand heterocyclic ring through an amine linkage in the current application.

- 10/587,448, now US 7,566,726 - The R8 and R17 groups on the ring on the left side of the structure cannot be hydrogen, whereas one of the corresponding groups in the current claims is hydrogen.

Summary

If the Examiner wishes to discuss any matter regarding this Response, she is invited to telephone the undersigned attorney.

This Response is timely filed, and no fees are believed to be due. If a fee is required in connection with this Response the fee may be charged to Merck Deposit Account No.: 13-2755

Respectfully submitted,

By: _____

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